

REMARKS

Claims 1-12 are pending and rejected in this present application. Claims 1, 6, 7 and 8 are hereby amended. Additionally, the drawings are objected to by the Examiner.

Responsive to the rejection of Claims 1-12 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention, Applicants have amended Claims 1, 6, 7, and 8. More particularly, Applicants have amended Claims 1, 6, 7, and 8, to clarify the limitation of the term "wound around said polepieces". Claims 1, 6, 7, and 8 are hereby amended to include the term "wound about said polepieces". The Examiner has interpreted the term "around" to indicate that the coil was "on" or touching the polepieces. The Applicants intended the word "around" to indicate that the coil encircles said pole pieces. The amendment of the Claims further clarifies this distinction. The amendments do not constitute new matter. More particularly, "a plurality of windings 18 about the polepieces" is disclosed on *page 4, line 9* of the specification as filed. Applicants respectfully submit that Claims 1-12 are now in allowable form.

Responsive to the Examiner's objection to the drawings under 37 C.F.R. 1.83(a), Applicants respectfully traverse. The Applicants do not claim "the coil wound on the polepieces", as indicated by the Examiner. The Examiner has interpreted the term "around" to indicate that the coil was "on" or touching the polepieces. The Applicants intended the word "around" to indicate that the coil encircles said pole pieces. The amendments of Claims 1, 6, 7, and 8 further clarify this distinction. The figures illustrate the coil 18 encircling the polepieces 14 and 16. In view of the foregoing comments, Applicants respectfully request that the objection to the drawings be withdrawn.

Responsive to the rejection of claims 1 -12 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No.5,779,220 (Nehl, et al.), Applicants respectfully traverse.

Nehl, et al. discloses a radial clearance, "between the bearing 98 and the wall of the bearing housing 78". (*Column 3, lines 41-44*). (*Fig. 2*). Additionally, Nehl, et al. discloses the
5 aforementioned bearing 98, not in a fixed position, but is free to float within the clearances to allow radial motion. (*Column 3, lines 44 and 45*). (*Fig. 2*).

In contrast Claims 1, 6, 7, and 8 recite in part, "a bearing axially disposed in one of said first and second polepieces". Additionally, the Applicants' specification discloses an, "axial bore
24' in second polepiece 16, ... retains a sleeve bearing 40 for radially supporting shaft 22' in
10 axial motion." (Page 5, lines 5-7). (*Fig.2*). Furthermore, the Applicants' specification discloses, "the axial length of bearing 40 is at least 1.5 times the diameter of shaft 22' to minimize wobble of the shaft in the bearing and resulting cocking of the armature in the polepieces." (*Page 5, lines 13-15*). (*Fig.2*).

The Examiner suggests that it would have been obvious to one having skill in the art to move the bearing to the polepiece. A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). The office action and Nehl, et al. fail to indicate any objective reason for moving the bearing to the polepiece. The Examiner suggests that having the bearing disposed in the polepieces does not solve any stated problem, to which the Applicants respectfully disagree. The solenoid of the Applicants'

invention is configured be used freely, without regard to orientation. Locating the bearing in the polepiece reduces the distance between the armature and the bearing, thereby minimizing radial displacement . This configuration serves to reduce the "wobble of the shaft".

Furthermore, if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The bearing disclosed in Nehl, et al. is not fixed in position, but is free to float within the clearances between the outer wall of the bearing and the bore, thereby allowing radial motion of the shaft. Modifying the invention by placing the bearing of Nehl, et al. in the polepiece would serve to promote "wobble of the shaft", thereby rendering the solenoid unsatisfactory for its intended purpose, operation of the solenoid in any orientation.

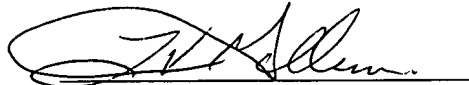
For the foregoing reasons, the Applicants respectfully submit that a prima facie case of obviousness has not been established. Applicants hereby respectfully submit that Claim 1-12 are in condition for allowance, which is hereby respectfully requested.

In the event Applicants have overlooked the payment of fee, or additional payment of fee, Applicants hereby conditionally petition therefore and authorize that any changes be made to Deposit Account No. 50-0831, DELPHI TECHNOLOGIES, INC.

Should you have any questions regarding the enclosed, please do not hesitate to contact me.

Respectfully submitted,

Dated: 6/20/03

A handwritten signature in black ink, appearing to read "Frank V. Gallucci", is written over a horizontal line.

Frank V. Gallucci
Reg. No. 51,211

JAECKLE FLEISCHMANN & MUGEL, LLP
39 State Street, Suite 200
Rochester, New York 14614-1310
Telephone: (585) 262-3640
Facsimile: (585) 262-4133